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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/162,768 | 09/30/1998 | JOHN S. HENDRICKS | 5315 | 9228 |

38598 7590 05/20/2004

ANDREWS KURTH L.L.P.
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WASHINGTON, DC 20006

EXAMINER

KOENIG, ANDREW Y

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2611

DATE MAILED: 05/20/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/162,768

Applicant(s)

HENDRICKS ET AL.

Examiner

Andrew Y Koenig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15,17,18,20-35,37-43,45,47-60,62,64-80,82-98,101-104,107-116,118 and 120-145 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1,3-15,17,18,20-35,37-43,45,47-60,62,64-80,82-98,101-104,107-116,118 and 120-145.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

In the amendment filed 10 December 2002, on page 1, para. 4, line 5, the "demodulator 134" should be "demodulator 136" as shown in figure 12b.

Appropriate correction is required.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 3-15, 17, 18, 20-35, 37-43, 45, 47-60, 62, 64-80, 82-98, 101-104, 107-116, 118, 120-145 have been considered but are moot in view of the new ground(s) of rejection.

The affidavit received 20 January 2004 is not persuasive and the rejection of claims 17 and 18 has been sustained. The combination of the Mr. Asmussen's opinion and the evidence has been considered but has been given no weight. Specifically, in that Mr. Asmussen appears to be related to other co-pending applications with at least one of the inventors of the instant application, please see U.S. Application 09/191,520, which has a common parent application (U.S. Application 07/991,074) with the instant invention. Furthermore, the evidence of exhibits 2 and 3 exemplifying the connectors using modulated and digital signals do not have any date associated therewith.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is understood that the terminal and the upgrade card could be remotely connected but one of skill in the art would not be enabled to receive modulated signals over a multipin connector (claim 17) or a DB9-DB25 (claim 18).

5. Claims 1, 3-15, 17, 18, 20-35, 37-43, 45, 47-60, 62, 64-80, 82-98, 101-104, 107-116, 118, 120-145 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support in the specification, for "a first tuner capable of selecting a digital audio signal" as recited in claim 1. It is recognized that the set top terminal 220, in turn, routes the digital audio signal to the components of the Level D hardware upgrade (see amendment filed 10 December 2002, pg. 1, para. 4, line 5). However, the

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specification is silent on the details of how the signal is routed to the components, specifically in that the tuner is capable of selecting a digital audio signal.

Independent claims 23, 37, 62, 80, 104, 110, 118, and 144 recite a similar limitation.

Claim 45 recites the limitation of "receiving ... audio programs using ... a first tuner." For the same reasons as stated above, there is no support in the specification for the first tuner in the set top terminal to receive audio programs. Again, it is noted that whereas the set top terminal routes the signals to the hardware upgrade, there is no support on the tuner receiving the audio signals.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ayk



VIVEK SRIVASTAVA
PRIMARY EXAMINER